

Hong et al. – Serial No. 09/512,019
Amdt. dated February 24, 2004
Reply to Office Action of August 26, 2003
and Advisory Action dated February 5, 2004

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

We first thank the Examiner for the courtesies extended to Applicant's representative in the telephone conversations on October 10, 2003 and February 12, 2004, during which the August 26, 2003 Office Action and February 5, 2004 Advisory Action were discussed at length.

The specification is amended above to correct the informalities regarding the Abstract pointed out by the Examiner in the Office Action dated August 26, 2003. Claims 1-8, 14-28, 31-38, and 41-56 are canceled without prejudice or disclaimer, as directed to a non-elected invention(s). Claim 11 is canceled without prejudice or disclaimer, as its subject matter is incorporated in independent claim 9. Claims 9, 29, and 39 are amended above to address the Examiner's concerns regarding informalities and 35 U.S.C. §112, first and second paragraphs. None of the amendments to these claims introduces new matter, and some of the amendments are made to clarify the invention or to correct grammar or verbosity. The amendatory language in independent claims 29 and 39 tracks the Examiner's suggested revisions in the Office Action. All amendatory language is fully supported by the original specification, for instance at page 19, line 11 – page 20, line 6; page 26, line 16 – page 27, line 8; the original claims 11, 16, 22 and 24; and the Examples. With entry of this amendment, claims 9, 10, 12, 13, 29, 30, 39 and 40 are pending. Entry and consideration of the amended specification and claims are requested.

In the Office Action, the specification is objected to for several informalities. The objection regarding the Abstract is believed to be corrected hereinabove. Regarding Figures 4-8, the Examiner noted that these figures include nucleotide sequences that require a sequence identifier. As discussed with the Examiner during the February 12 telephone conversation, we have reviewed Figures 4-8 and now realize that these sequences need to be added to the Sequence Listing filed previously, and given the

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appropriate sequence identifiers. We are immediately undertaking to prepare a Substitute Sequence Listing to include the originally-listed eleven sequences and the sequences in Figures 4-8. We will file it as soon as possible, with a Supplemental Amendment to include the proper sequence identifiers in the brief description of Figures 4-8.

Along these lines, we note that Figures 4-8 show the results of testing the HiFi Bst and HiFi Bst-II DNA polymerases in dye-labeled primer DNA sequencing, dye-labeled terminator DNA sequencing. The sequences in Figures 4, 5, 6 and 8 relate to the pGEM[®]-3Zf(+) Vector, which plasmid is a commercially-available standard cloning vector with a well-known sequence, useful as a template for in vitro transcription and for the production of circular ssDNA. The sequences in Figure 8 relate to the M13mp18 phage vector derived from bacteriophage M13 propagated in E. coli. It also is a commercially-available, widely used plasmid, whose sequence is well-known.

Claims 29, 39 and 40 are objected to for several informalities, all of which are believed to be rendered moot by the above claim amendments.

Claims 9-13, 29-30 and 39 were rejected as indefinite under 35 U.S.C. §112, second paragraph. We have amended independent claims 9, 29, and 39 per the Examiner's suggestions in the Office Action (for claims 29 and 39), and in the October 10 telephone conversation (for claim 9), and in the February 12 telephone conversation (for claims 29 and 39). This is believed to make the claims quite clear in the intent and scope of this invention.

Claims 9, 10 and 13 were rejected under 35 U.S.C. §112, first paragraph. While we strongly disagree with the Examiner that the specification only enables claims limited to SEQ ID NO:4, in the interest of advancing allowance of this application we have amended independent claim 9 to specify that the DNA polymerase has the amino acid sequence of SEQ ID NO:4. This, we believe, should address the Examiner's concerns as stated, and withdrawal of this rejection is thought to be in order.

In summary, all of the Examiner's outstanding rejections and objections have been addressed, and the application is believed to be in allowable form. Notice to that effect is earnestly solicited. No amendment made was related to the statutory requirements of patentability unless expressly stated herein, and no amendment made was

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for the purpose of narrowing the scope of any claim unless we argued above that such amendment was made to distinguish over a particular reference or combination of references.

If the Examiner has any questions or would like to make suggestions as to claim language, he is encouraged to contact Marlana K. Titus at (301) 977-7227 (**note that this is a new telephone number**).

By: 

Marlana Titus, Reg. No. 35,843
Tel. No. (301) 977-7227

Nash & Titus, LLC
6005 Riggs Road
Laytonsville, MD 20882